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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,416	12/10/2001	Cynthia C. Bamdad	A-67032-2/RFT/RMS/RMK	1226

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07/06/2004

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EXAMINER

LU, FRANK WEI MIN

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 07/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/016,416

Applicant(s)

BAMDAD ET AL.

Examiner

Frank W Lu

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 14 June 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 20-25,36 and 37.Claim(s) withdrawn from consideration: 26.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: PTO- 892

ADVISORY ACTION

1. The proposed amendments filed on June 14, 2004 have been fully considered but will not be entered because they raise new issues that would require further consideration and/or search.

The examiner notes that applicant adds the phrase “an electron transfer moiety” into claim 36 in the amendment filed on June 14, 2004. Although claim 18 filed on November 24, 2003 contains “an electron transfer moiety”, claim 36 filed on November 24 does not have the phrase “an electron transfer moiety”. Therefore, the phrase “an electron transfer moiety” is considered as a new limitation for claim 36 that raises new issues that would require further consideration and/or search. For example, the examiner needs to reconsider the rejection mailed on March 10 in view of the amendment filed on June 14, 2004.

Response to Arguments

Note that following response to arguments are based on the amendment filed on November 24, 2003 and are not based on the amendment filed on June 14, 2004.

I. In page 3, last paragraph bridging to page 4, first paragraph of applicant's remarks, applicant argues that “[W]hile the Examiner has asserted that activation of fluorescence is known in the art to include electron transfer, Applicants respectfully submit activation of fluorescence does not involve electron transfer, but rather energy transfer in the form of photons. The Examiner is respectfully directed to the Molecular Probes Handbook, page 1, (a copy of which is attached as Exhibit ‘A’ for the Examiner's convenience) which describes the fluorescence process. The process involves three steps, (1) absorption of a photon from an external energy source, which causes the fluorophore to change conformation to an excited ‘singlet’ state, followed by (2) relaxation from the excited singlet state to the relaxed singlet state, and finally

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(3) emission of a photon which causes the fluorophore to return to its original state. At no point does this process involve the transfer of electrons. Accordingly, the Examiner has not shown that Heller teaches electron transfer”.

This argument has been fully considered but it is not persuasive toward the withdrawal of the rejection. Although fluorescence energy transfer may somehow include photons, applicant’s argument is based on whether a fluorescence dye can be considered as an electron transfer moiety. According to the definition, electron transfer moieties are molecules capable of electron transfer under certain conditions (see the specification, page 50, six paragraph). In the examiner’s opinion, a fluorescence dye is an electron transfer moiety because it is capable of electron transfer under certain conditions. The references from Seidel *et al.*, (J. Phys. Chem., 100, 5541-5553, 1996) and Edman *et al.*, (Proc. Natl. Acad. Sci. USA, 93, 6710-6715, 1996) support the examiner’s position wherein photoinduced electron transfer plays an important role for nucleotide-specific quenching (see Seidel *et al.*, page 5541, right column, last paragraph and page 5551; see Edman *et al.*, page 6712, right column, fifth paragraph). Therefore, since a fluorescence dye is an electron transfer moiety that is capable of electron transfer under certain conditions, Heller *et al.*, teach all limitations recited in claims 18, 17, 36, and 37.

II. In page 4, fourth and fifth paragraph of applicant’s remarks, applicant argues that the rejections under 35 U.S. C 103 (a) should be withdrawn because “fluorescent beads and particles are not electron transfer moieties”.

This argument has been fully considered but it is not persuasive toward the withdrawal of the rejection since, as mentioned above, a fluorescence dye is an electron transfer moiety.


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2. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is either (703) 308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (571)272-0746. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached on (571)272-0782.

Any inquiry of a general nature or relating to the status of this application should be directed to the Chemical Matrix receptionist whose telephone number is (703) 308-0196.


FRANK LU
PATENT EXAMINER

Frank Lu
PSA
June 29, 2004